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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,773	01/29/2004	Daniel C. Edelstein	END920030116US1	7040
30449	7590	05/04/2005	EXAMINER	
SCHMEISER, OLSEN + WATTS			ABRAHAM, FETSUM	
3 LEAR JET LANE			ART UNIT	
SUITE 201			PAPER NUMBER	
LATHAM, NY 12110			2826	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,773

Applicant(s)

EDELSTEIN ET AL.

Examiner

Fetsum Abraham

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-33, 36, 37 and 40-44 is/are rejected.
- 7) ☒ Claim(s) the rest is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's election has been acknowledged and the arguments to traverse the election requirement considered. The argument that the method claims do not impose a burden of examination is not accepted by the examiner. Not only is a big portion of the specification but the method claims also have languages that indicate processing steps and material methods of accomplishing the steps that clearly impose a burden for examination. Typical examples are claims 1,6,11,12,15,21 and claims 8,23,24, that require specific steps and application of performing the steps by specific methods. Therefore, the non-elected claims 1-30 have been withdrawn from examination.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-33,36,37,40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al (6,852,605).

The prior art shows an inductor in figure 10 comprising sidewalls (124,30,18), a top surface in (50) and a bottom surface in (20) the lower portion (20) extending a fixed distance into a dielectric layer (22) formed on a substrate (10) and the upper portion (50) extending above the dielectric layer (22). Although the prior art may not have discussed means for electrically connecting the inductor, it would have been obvious to ones skilled in the art to safely assume the prior art as having one because inductors are electrical components usable in electrical circuits such as tuning circuits and step-up

Art Unit: 2826

and step-down environments that require connection to other devices such as capacitors.

As for claims 32,33 the inductor has single conductive liners (14,18) and a core conductor within its upper portion (50) of the claimed materials. Although the liner is a single conductor of the claimed material, it would have been obvious to one skilled in the art to double the layer in order to increase the barrier capacity and conductivity of the same.

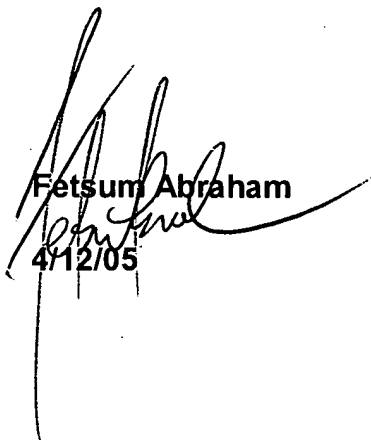
As for claims 36,37 height, width, thickness and distance are variable nature of the art that can vary from a design to another to meet a specific circuit requirement that cannot be patented in singularity unless criticality is an issue. Because the specification contains no disclosure of either the critical nature of the claimed arrangement or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

As for claim 40, the one embodiment of the prior art is a spiral inductor of the claimed structure (see figure 11a). As for claims 41-44, inductance is also a function of spacing and q factor that is variable in a spiral configuration and in the art overall that can vary from a design to another to meet a specific circuit requirement.

Claims 34,35,38,39,45-61 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fetsum Abraham whose telephone number is: 571-272-1911. The examiner can normally be reached on 8:00 - 18:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J Flynn can be reached on 571-272-1915.


Fetsum Abraham
4/12/05